

## REMARKS

The applicant has carefully considered the Office action dated April 4, 2005 and the references it cites. By way of this Response, claim 1 has been amended and new claims 46-48 have been added. In view of the following, it is respectfully submitted that all pending claims are in condition for allowance and favorable reconsideration is respectfully requested.

### Preliminary Matters

As an initial matter, the applicants note that claims 25 and 36-45 stand allowed and are not further discussed in this paper.

As a second initial matter, the undersigned wishes to thank the Examiner for his participation in a telephonic interview on April 11, 2005. The sole topic discussed in that interview was the treatment of the PTO-1449 form submitted with the information disclosure statement received at the USPTO on January 18, 2005. Specifically, during that interview, the undersigned pointed out that the references had been incorrectly crossed out on the PTO-1449 form. In particular, although the Office action only objected to references C01-C02, all of the references including references A01-A40 and B01 had been improperly crossed out on the PTO-1449 form. The US and foreign references had all been properly cited. Therefore, it was improper to cross those references out. Further, at least one of the "other document" publications (i.e., publication C02) was dated. Therefore, it was incorrect to cross that reference out. In response, the Examiner indicated that the undersigned should re-submit a copy of the PTO-1449 and that he would initial the references to make it clear that they had been considered in full.

With respect to reference C01, the applicants cannot date the reference as it is the undated publication of a third party. Therefore, the Office action unfairly attempts to charge the applicants with an impossible task, namely, dating a document to correct a third party's author's omission. Applicants complied with their duty of disclosure by properly submitting the reference for consideration. It is not the applicants' fault that the third party did not date its document, and, therefore, the applicants should not be prejudiced by this issue. To facilitate examination, the applicants hereby admit that documents C01 and C02 are prior art to the instant application. Accordingly, the Office is requested to consider these references in full as part of the body of prior art when considering the patentability of the pending claims. To this end, a supplemental information disclosure statement re-submitting all of the references from the prior information disclosure statement and identifying three additional US patents found in analyzing the arguments raised in the Office action is attached.

#### **Art Rejections**

Turning to the art rejections, the Office action rejected claims 1-7, 12-30 and 35 as being unpatentable over one or more of Oren, U.S. Patent 359,869, O'Neill, U.S. Patent 5,930,854, Potter, U.S. Patent 2,475,515, Kim, U.S. Patent 4,750,509, and/or Jakubowski et al., U.S. Patent 6,301,731. Applicants respectfully traverse these rejections as based on errors of law and fact.

As an initial matter, applicants note that the Office action improperly ignores many recitations of the pending claims. This is clearly reversible

error. The law has long been clear that a "disregard of claim limitations, as here, would render claim examination in the PTO meaningless." Panduit Corp. v. Dennison Manufacturing Co., 1 U.S.P.Q.2.d 1593, 1603 (Fed. Cir. 1987).

The Office action apparently attempts to justify its disregard of express claim recitations by characterizing the ignored language as "functional."

However, *it is fundamental error to ignore any claim language* based on its form, be it functional or otherwise. As explained in the MPEP:

A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in way that are contrary to accepted meanings in the art. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in In re Swinehart, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

MPEP 2173.01 (emphasis added). Indeed, § 2173.05(g) of the MPEP expressly states, "a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." Thus, there is clearly nothing improper with using functional language in a claim. On the contrary, it is clear error for the Office to ignore that functional language as has been done in the Office action at issue.

Finally, the Office is respectfully reminded that the “fact that claims receive their broadest reasonable meaning during the patent examination process does not relieve the PTO of its essential task of examining the entire patent disclosure to discern the meaning of claim words and phrases.” Rowe v. Dror, 42 U.S.P.Q.2d 1550, 1555 (Fed. Cir. 1997). Further, “claims are read in light of the disclosure of the specification on which they are based, not in a vacuum.” In re Dean, 130 U.S.P.Q. 107, 110 (C.C.P.A. 1961). The Office action does not follow these legal principles, but instead ignores express claim recitations to give the pending claims an intentionally overbroad and unreasonable meaning. Such an approach to examination is unmistakably inappropriate. The Patent Office is charged with assisting inventors with securing patents to protect their inventions, not with ignoring claim terms to intentionally frustrate an applicants’ legitimate pursuit of patent protection.

#### **Claim 1**

Turning to claim 1, the Office action erroneously contends that claim 1 is anticipated by Oren, O’Neill, or Potter. However, claim 1 recites at least one fastener to couple the floor mat to a play yard and/or a bassinet. None of Oren, O’Neill or Potter teaches or suggests such a structure.

For example, while Oren shows a floor mat, there is absolutely no hint of a fastener to couple the floor mat of Oren to a play yard and/or a bassinet as recited in claim 1. As such, the § 102 rejection based on Oren is plainly in error and must be withdrawn.

Similarly, no person or ordinary skill in the art would mistake O’Neill’s entertainment device for a playpen or bassinet. (Indeed, O’Neill’s

background section makes it clear that its device is intended in place of a playpen which O'Neill characterizes as "little more than an unaesthetic 'cage' around the infant." Col. 1, lines 19-23). As such, O'Neill cannot in any way be said to provide a floor mat dimensioned to be positioned within a play yard and/or a bassinet<sup>1</sup> or a fastener to couple such a floor mat to a play yard and/or a bassinet as recited in claim 1. Consequently, the § 102 rejection based on O'Neill is plainly in error and must be withdrawn.

Potter is similarly deficient. Potter provides an insect excluding compartment wherein "an infant or an invalid may obtain the beneficial rays of the sun and fresh air while being protected from ants, flies, mosquitoes, and

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<sup>1</sup> The recitation of the dimensions of the floor mat is a *structural* recitation and must be considered as having patentable weight. The well known case, Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565 (Fed. Cir. 1986), is instructive on this point. In the Orthokinetics case, the patentee was asserting a claim reciting "wherein said front leg portion is so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats thereof." In sustaining the validity of the claim, the Federal Circuit stated "The claims were intended to cover the use of the invention with various types of automobiles. That a particular chair on which the claims read may fit in some automobiles and not others is of no moment. The phrase 'so dimensioned' [as to be insertable through the space between the doorframe of an automobile and one of the seats thereof] is as accurate as the subject matter permits, automobiles being of various sizes." (*Id.* at 1576) (citations omitted and emphasis added). Thus, it is self-evident from the Orthokinetics case that a recitation such as "a floor mat dimensioned to be positioned within a play yard and/or a bassinet," is a proper claim recitation that cannot be ignored by the USPTO.

This point is conclusively demonstrated by Moore U.S.A., Inc., v. Standard Register Co., 229 F.3d 1091, 1111 (Fed. Cir. 2000). In that case, the Federal Circuit stated, "[w]e note that there is nothing wrong with defining the dimensions of a device in terms of the environment in which it is to be used." Moore, 229 F.3d at 1111. In other words, there is nothing wrong with defining a claimed element in terms of the environment in which it is intended to be used and ignoring such recitations during examination is plainly legal error.

particularly disease carrying insects.” As such, its floor mat is intended to be positioned on a ground surface in the outdoors. There is no hint in Potter of a fastener to couple the floor mat to a play yard and/or a bassinet as recited in claim 1. Accordingly, the § 102 rejection based on Potter is plainly in error and must be withdrawn.

In view of the foregoing, it is respectfully submitted that the rejections of claim 1 and all claims depending therefrom based on Oren, O’Neill and/or Potter are in error and must be withdrawn.

#### **Claim 20**

Turning to independent claim 20, the Office action erroneously contends that O’Neill anticipates that claim and, in the alternative, that claim 20 is rendered obvious by Jakubowski when considered in view of O’Neill. Applicants respectfully traverse these rejections.

Claim 20 recites, among other things, “a plurality of connectors coupled to the mat to be moved between a first position *within a perimeter of the mat* and a second position *outside the perimeter of the mat*.” In making the § 102 rejection, the Office action contends that connectors 16 of O’Neill meet this recitation. However, even a cursory review of O’Neill unmistakably demonstrates that the connectors 16 are *always located outside the perimeter of the mat 14*. They do not have a “position within a perimeter of the mat” and cannot in any way be imagined as being coupled to the mat 14 “to be moved between a first position within a perimeter of the mat and a second position outside the perimeter of the mat.” As such, the § 102 rejection based on O’Neill is in error and must be withdrawn.

The § 103 rejection of claim 20 based on Jakubowski and O'Neill is also in error. As an initial matter, the Office action fails to identify a legally cognizable suggestion for combining Jakubowski and O'Neill. In this regard, the Office action states: "it would have been obvious for one having ordinary skill in the art at the time of the invention to employ a play gym as taught by O'Neill to suspend an object above the mat of Jakubowski in order to encourage the infant to look up and reach out." However, as a matter of law and fact, this is not a proper suggestion for combining Jakubowski and O'Neill.

Turning first to the legal error, Applicants wishes to remind the Office of the bedrock legal principles for rejecting a claim under 35 U.S.C. § 103. Specifically, in In re Rouffet, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) the Federal Circuit explained:

To reject claims in an application under section 103, an examiner must show an un rebutted prima facie case of obviousness. In the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent.

Id. at 1455 (citations omitted and emphasis added).

In the Rouffet case, the Examiner had rejected the pending claims on a combination of references. The Board sustained the Examiner. However, the Federal Circuit reversed the Board's decision and ruled that the Examiner's rejections were legally impermissible because they failed to demonstrate a suggestion for combining the references in the manner proposed by the Examiner. As explained by the Federal Circuit:

As this court has stated, “virtually all [inventions] are combinations of old elements.” Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness.

Id. at 1457-58 (citations omitted and emphasis added). These principles have not been followed in rejecting claim 20. Merely stating an advantage or possible advantage of combining references, as was done to reject claim 20, is not the same as “show[ing] a motivation to combine the references.”

On the contrary, in order to establish a prima facie case of obviousness, there must be actual evidence of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be clear and particular. In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In order to establish a prima facie case of unpatentability, particular factual findings demonstrating the suggestion to combine must be made. See, for example, Ecolochem Inc. v. Southern California Edison, 56 U.S.P.Q.2d 1065, 1072-73 (Fed. Cir. 2000) and In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617-1618 (Fed. Cir. 1999). Indeed, the law



is quite clear that an obviousness rejection must be based on facts, not conjecture.

The Supreme Court... foreclosed the use of substitutes for facts in determining obviousness under section 103. The legal conclusion of obviousness *must be supported by facts*. Where the legal conclusion is not supported by facts it cannot stand.

In re Warner, 379 F.2d 1011, 1017 (C.C.P.A. 1967). This longstanding principle has been followed to date. For example, in the unpublished Board decision, Ex parte Megens, App. No. 1999-0277 (B.P.A.I. Oct. 29, 1999), the Board stated:

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, an examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.

The examiner's conclusion that it would have been obvious to incline Phillips' loading dock floor 65 rests on the completely unfounded assumption that it would be desirable to drain liquid from the floor. The Phillips reference, however, is devoid of any indication that liquid might accumulate on the floor or that such accumulation would pose a problem even if it did occur. It is therefore apparent that the examiner has resorted to improper speculation and hindsight reconstruction to overcome the admitted deficiency of Phillips vis-à-vis the subject matter recited in claim 1.

(Megens at Pages 4-5)(emphasis added).

This is precisely the situation presented here. The "suggestion" in support of the rejection of claim 20 amounts to nothing more than a

speculative statement that, given the alleged presence of the claim elements in the prior art and an advantage that combining these elements would allegedly achieve, a person skilled in the art would have found it obvious to combine the references to create the claimed invention. The problem with this approach is that it effectively eliminates the requirement of identifying a suggestion for combining references from the obviousness analysis. More specifically, the analysis present in the Office action proceeds in the following manner:

- a) What elements are present in the pending claims?
- b) Can these elements be found in prior art references?
- c) If they can be found, and the references themselves provide no suggestion for combining these elements, can some end or advantage be identified to combine the elements in the manner proposed in the Applicants' claims?
- d) If so, combine the elements in the manner proposed by the Applicants and reject the pending claims.

This mode of analysis is, of course, deeply flawed. Specifically, as noted by the Federal Circuit in the Rouffet quote identified above, all of the elements of most claimed inventions can almost always be found in the prior art. Therefore, the answer to step "b" above will almost always be "yes". Since it is a statutory requirement that all inventions have utility, there will also always be an identifiable end or advantage in combining the elements in the prior art in the manner proposed by any claim (e.g., if there was no purpose to an element in a claim it would not be included in the claimed apparatus, after all, who would pursue a claim with superfluous elements or a claim with no utility?). Therefore, if the "suggestion" requirement of 35

U.S.C. § 103 can be met by merely identifying any end or advantage which will be achieved by combining the elements of the prior art references, the suggestion requirement can always be met and is utterly meaningless.

This inherent flaw in the analysis employed in rejecting claim 20 is elucidated by viewing the alleged “suggestion” the Office action identifies in support of the rejection. As noted above, in rejecting claim 20, the Office action states: “it would have been obvious for one having ordinary skill in the art at the time of the invention to employ a play gym as taught by O’Neill to suspend an object above the mat of Jakubowski in order to encourage the infant to look up and reach out.” The first part of the statement, namely, “It would have been obvious ... to employ” is merely boilerplate language that does not address the suggestion requirement. The second part of the statement, namely, “to employ a play gym as taught by O’Neill to suspend an object above the mat of Jakubowski” simply states what the proposed modification of the primary reference is to be; in this case modifying Jakubowski to include a play gym. This second part of the statement, thus, describes the proposed modification, but offers no explanation of a motivation for making that modification. The final part of the statement, namely, “in order to encourage the infant to look up and reach out,” must, then be the alleged “motivation” for modifying Jakubowski.

However, while it is true that one possible advantage of mounting a play gym above a play yard is that it might encourage an infant to look up and reach out, that is not a suggestion in and of itself for using a play gym in Jakubowski. “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the

prior art suggested the desirability of the modification.” In re Fritch, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992)(emphasis added). Here, the Office action does not identify any evidence in the prior art indicating or in any way suggesting the desirability of the proposed modification. It only identifies an old element that has an inherent property. Indeed, the Office action’s naked, conclusory statement amounts to nothing more than stating “A person of ordinary skill in the art would be motivated to modify Jakubowski’s play yard to include a play gym because they would want to gain a benefit from having a play gym on a play yard.” In other words, the Examiner is effectively saying that the motivation of adding a play gym to Jakubowski is to have the inherent benefit of adding a play gym to a play yard (i.e., entertainment). Of course, such circular reasoning (i.e., add “X” to have “X”) cannot be a legally proper tool for identifying a suggestion for combining references. If it were, no combination of old elements would ever be patentable since one can always nakedly state, a person would be motivated to add old element X from one reference to another reference because adding element X offers an advantage (again, if adding “X” had no advantage, who would ever claim it?). Simply put, there is *always* an advantage to combining old elements that can be identified through hindsight *once that combination is known*.

It should be quite clear from the above that merely identifying an advantage for adding an old element to a combination of elements is not a proper suggestion for making that combination. The MPEP further proves this point. In particular, MPEP § 2144 states that “the strongest rationale for combining references is a recognition... in the prior art or... based on established scientific principles or legal precedent, that some advantage would

have been produced by their combination.” The MPEP cites In re Sernaker, 702 F.2d 989, 994-95 (Fed. Cir. 1983) to support this proposition.

Looking at the Sernaker case, we see that the Federal Circuit states: “The lesson of this case appears to be that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.” Sernaker, 702 F.2d at 995-96 (emphasis added). Notice that this statement does not state that it is obvious to combine references simply because there is an advantage to doing so. On the contrary, it carefully states that there can be no obviousness ruling unless something in the art suggests an advantage to combining the references. The advantage itself is not the suggestion, but rather the Court makes it clear that something else suggests the advantage.

The MPEP quote noted above is similar. It states that the “strongest rationale for combining references is a recognition... in the prior art or... based on established scientific principles or legal precedent that some advantage or expected beneficial result would have been produced by their combination.” (MPEP, Page 2100-127) (emphasis added). This, of course, does not state that the strongest rationale for combining references is the mere presence of an advantage to doing so. Instead, as in Sernaker, the strongest rationale is a recognition (i.e., a suggestion) in the art that an advantage will result.

Turning back to the rejections at issue, rather than identifying something in the art that suggests an advantage to making the combination, the Office action just looks for the advantage itself and mislabels that advantage

as “suggestion.” As explained above, this is a literal elimination<sup>2</sup> of the suggestion requirement. Since there is always an advantage to a claimed element (or why would you claim it?), the Office action’s misplaced view of an advantage as the suggestion inherently renders all combinations of old elements unpatentable precisely because it eliminates the suggestion requirement from the analysis. Clearly, neither the MPEP section noted above nor the Sernaker case upon which that MPEP section rests for authority stands for the proposition that an advantage of an element is a suggestion in and of itself for including that element in a combination.

In view of the foregoing, applicants respectfully submit that the § 103 rejection of claim 20 must be withdrawn because it fails to identify a legally proper suggestion for combining the prior art references in the manner proposed by the Office action. In other words, the Office has failed to establish a prima facie case of obviousness under 35 U.S.C. § 103. On this basis alone, the rejections of claim 20 and all claims depending therefrom must be withdrawn.

Before leaving the suggestion issue, applicants respectfully submit that, the reason the Office action fails to identify a legally proper suggestion for combining Jakubowski and O’Neill, is that no such suggestion exists. For instance, nothing in Jakubowski suggests any need for a play gym. Jakubowski entertains the occupant of its play yard through side mounted panels 40 and/or by toys strapped to the sides of the play yard via fasteners 38. Nowhere does Jakubowski suggest that these forms of entertainment are

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<sup>2</sup> It literally removes the “recognition” portion of the MPEP quote above and the “something in the art” portion of the Sernaker quote.

insufficient or need to be supplemented with a structure such as a play gym mounted over the occupant. Indeed, it would appear that such a structure would have a tendency to draw the attention of the occupant away from Jakubowski's improvement, namely the entertainment side panels.

Further, O'Neill seeks to provide an alternative to a play yard (O'Neill, Col. 1, lines 8-27). Since Jakubowski expresses no need for additional stimulation in the form of a play gym, and since O'Neill seeks to provide an alternative to placing a child in a play yard, without improper reference to the teachings of applicant's application, a person of ordinary skill in the art would have no motivation to pick and choose structures from O'Neill to include on Jakubowski.

Further, even if there were a suggestion for combining Jakubowski and O'Neill (there is not), one would still not arrive at the combination recited in claim 20. As noted above, O'Neill does not teach or suggest connectors which have a "position within a perimeter of the mat" or which are coupled to the mat 14 "to be moved between a first position within a perimeter of the mat and a second position outside the perimeter of the mat." Jakubowski in no way corrects this deficiency. There are no connectors coupled to the Jakubowski mat, or any suggestion as to how or why anyone would couple any connectors to the mat 36. Accordingly, irrespective of how one combines Jakubowski and O'Neill, one does not arrive at the recitations of claim 20.

In view of the foregoing, the rejections of claim 20 have been shown to be in error. Accordingly, claim 20 and all claims depending therefrom must be allowed.

#### **Claim 24**

Independent claim 24 is also allowable. Claim 24 recites a floor mat of a play yard and/or a bassinet; and a play gym dimensioned<sup>3</sup> to be removably secured to the floor mat to suspend an object above the mat when the mat is removed from the play yard and/or the bassinet. None of the art of record, whether taken alone or in combination teaches or suggests combining the floor mat of a play yard and/or bassinet with a play gym.

The Office action rejects claim 24 as being obvious based on Jakubowski when considered in view of O'Neill. This rejection is "supported" by the same improper suggestion as the rejection of claim 20. As discussed above, the alleged suggestion identified in the Office action is not a legally proper suggestion for combining Jakubowski and O'Neill. On this basis alone, the rejection of claim 24 must be withdrawn.

Further, even if there were a suggestion for combining Jakubowski and O'Neill (there is not), one would still not arrive at the combination recited in claim 24. While one might conceivably consider mounting a play gym on the upper edge of Jakubowski's play yard, neither Jakubowski nor O'Neill provide any suggestion of mounting a play gym to Jakubowski's floor mat. Accordingly, the rejection of claim 24 is in error and must be withdrawn.

#### **Claim 26**

Independent claim 26 is also allowable. Claim 26 recites a bassinet and/or a play yard having a removable floor mat; and a play gym structured to

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<sup>3</sup> As noted above, this is a structural recitation and cannot be ignored.



suspend an object above the floor mat when the floor mat is positioned within at least one of the bassinet and/or the play yard, and to suspend the object above the floor mat when the floor mat is not positioned within the at least one of the bassinet and/or the play gym. None of the art of record, whether taken alone or in combination teaches or suggests combining the floor mat of a play yard and/or bassinet with a play gym.

The Office action rejects claim 26 as being obvious based on Jakubowski when considered in view of O'Neill. This rejection is "supported" by the same improper suggestion as the rejection of claim 20. As discussed above, the alleged suggestion identified in the Office action is not a legally proper suggestion for combining Jakubowski and O'Neill. On this basis alone, the rejection of claim 26 must be withdrawn.

Further, even if there were a suggestion for combining Jakubowski and O'Neill (there is not), one would still not arrive at the combination recited in claim 26. Neither Jakubowski nor O'Neill provide any suggestion of *a play gym structured* to suspend an object above the floor mat *when the floor mat is positioned within* the bassinet and/or the play yard, *and* to suspend the object above the floor mat *when the floor mat is not positioned within* the bassinet and/or the play gym. Accordingly, the rejection of claim 26 is in error and must be withdrawn.

#### **Claim 27**

Independent claim 27 is also allowable. Claim 27 recites a floor board for a play yard and/or bassinet comprising a mat; and a connector coupled to the mat to be moved between a first position within a perimeter of the mat and

a second position outside the perimeter of the mat. None of the art of record, whether taken alone or in combination teaches or suggests such a floor board.

The Office action erroneously argues that claim 27 is anticipated by O'Neill. First, it is noted that this rejection is based on the erroneously prospect that claim recitations can be ignored. As discussed above, this is legal error. In support of this effort, the Office action argues, "in response to applicant's recitation 'for a play yard or bassinet', a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art." The applicants respectfully note that this statement implicitly acknowledges that, at least in some circumstances (i.e., when a structural difference results), a "recitation of the intended use" can "patentably distinguish the claimed invention from the prior art" and, thus, *cannot* be ignored. Second, the applicants note that the mat 12 of O'Neill is not structured to act as a floor board for a play yard and/or bassinet, but rather is irremovably coupled to an inflatable ring 8. Thus, even under the Office action's own statement, the O'Neill floor mat 12 is structurally different from the floor board of a play yard and/or bassinet, and, thus, the recitation of "for a play yard and/or bassinet" cannot be ignored by the Office.

Further, the Office action states, "If the prior art structure is capable of performing the intended use, then it meets the claim." As noted above, the mat 14 of O'Neill, coupled as it is to an inflatable ring, is not capable of

serving as a floor board in a play yard and/or bassinet.<sup>4</sup> Thus, under the Office action's own statements, the O'Neill reference fails to meet the recitations of claim 27.

Moreover, as discussed above, the connectors 16 of O'Neill are *always* located *outside the perimeter* of the mat 12, 14. They do not have a "position within a perimeter of the mat" and cannot in any way be said to be "coupled to the mat to be moved between a first position *within a perimeter of the mat* and a second position *outside the perimeter of the mat*" As such, the § 102 rejection of claim 27 and all claims depending therefrom based on O'Neill are in error and must be withdrawn.

#### **Claim 29**

Independent claim 29 is also allowable. Claim 29 recites a play gym comprising at least two legs, each of the legs having an end dimensioned to be removably coupled to: (a) a bassinet and/or a play yard, and (b) a floor mat separate from the bassinet and/or the play yard. None of the art of record, whether taken alone or in combination, teaches or suggests such a play gym.

The Office action rejected claim 29 as being anticipated by O'Neill. In support of this rejection, the Office action argues that the inflatable ring 8 is a play yard and/or a bassinet. While this is a broad construction of the terms "play yard" and "bassinet", it is not a reasonable construction.

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<sup>4</sup> An inflatable ring in a play yard would, for example, present a danger that the occupant could use the ring as a step to climb out of the safety of the play yard and possibly fall to the floor. Therefore, no person of ordinary skill in the art would find the floor mat 14 of O'Neill to be a floor board for a play yard or believe that O'Neill's floor mat 14 would be capable of performing the function of such a floor board.

In this regard, the Office is respectfully reminded that claims are read in light of the disclosure of the specification on which they are based, not in a vacuum. In re Dean, 130 U.S.P.Q. 107, 110 (CCPA 1961). “Moreover, claims are construed as they would be by those skilled in the art.” Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 867 (Fed. Cir. 1985). Further, “a general rule of interpretation is that words in a claim will be given their ordinary and accustomed meaning, unless it appears that the inventor used them differently.” Casler v. United States, 15 Cl. Ct. 717 (1988). The fact that claims receive their broadest reasonable meaning during the patent examination process “does not relieve the PTO of its essential task of examining the entire patent disclosure to discern the meaning of claim words and phrases.” Rowe v. Dror, 42 U.S.P.Q.2d 1550, 1555 (Fed. Cir. 1997).

No person of ordinary skill in the art would ever consider the inflatable ring 8 of O'Neill to be a play yard or a bassinet. The terms play yard and play pen are used interchangeable in the art (see, for example, Pope et al., U.S. Patent 5,904, 344, Col. 1, ll. 43-44, Raffo et al., U.S. Patent 6,041,455, Col. 1, lines 13-14, and Warner, Jr. Et al., U.S. Patent 6,735,796, Col. 1, lines 8-10). As shown in Appendices 1-10, the term “play pen” or “play yard” is widely understood to be “a portable structure that forms a small enclosure for a baby to play safely.” (Appendix 2, MSN Encarta, Appendix 7, Dictionary.Com, Appendix 8, UltraLingua English Dictionary, Appendix 9, WordNet 1.7 Vocabulary Helper, and Appendix 10, LookWAYup.com). The point of a play yard is to provide a safe environment in which an infant or small child may be placed without fear of their moving to an unsafe location which the attending parent is not looking. The safety feature of the play yard is readily

apparent in many definitions that indicate that the baby or young child can be “safely left to play.” (See, for example, Appendix 2, MSN Encarta, Appendix 3, Compact Oxford English Dictionary, Appendix 4, Cambridge Advanced Learner’s Dictionary, Appendix 5, Wordsmyth, and Appendix 6, The American Heritage Dictionary). Therefore, the broadest reasonable construction is “a small enclosure for a baby to play safely” as shown by the definitions noted above.

These dictionary definitions are consistent with the use of the term “playpen” or “play yard” in the US Patent literature. For example, O’Neill states “playpens comprise an enclosure wall supported on the floor within which an infant is placed.” O’Neill goes on to state that playpens “provide little more than an unaesthetic ‘cage’ around the infant.” (Col. 1, lines 20-23). The dictionary definitions are also consistent with the usage of the term “play yard” in applicants’ specification. The Office appears to agree with this definition in that it states “a play yard is defined as a portable enclosure in which a baby can be left to play.”

With this definition in mind, it is easy to see that the inflatable ring 8 of O’Neill is not an enclosure. A child can crawl in or out of it at any time. Thus, the ring 8 is not “a portable enclosure in which a baby can be left to play” as defined in the Office action. The ring does not limit the mobility of a child (i.e., a child can crawl out at any time). Therefore, the ring 8 is not an enclosure in which a child can be “left to play.” Indeed, no reasonable parent looking to purchase a play yard would ever consider the O’Neill activity apparatus as a reasonable substitute for a playpen. This is, of course, because the O’Neill device is not an enclosure (the low height of the ring 8 is pointed

out at Col. 4, ll. 50-52 of O'Neill when it states "the infant can lie diametrically across the device.") For instance, it is inconceivable that a parent would leave a young child to play in the O'Neill device while he/she left the room (e.g., to answer a telephone, prepare food, use a restroom, etc.) for such a child could quickly crawl off to an unsafe area such as an open staircase. Accordingly, the O'Neill ring 8 does not meet any broad and *reasonable* definition of a play yard, including the definition proposed in the Office action ("a portable enclosure in which a baby can be left to play.")..

In view of the foregoing, it is respectfully submitted that the rejection of claim 29 is in error and must be withdrawn.

#### **Claim 46**

New independent claim 46 is also allowable. Claim 46 recites a floor mat; a play gym to suspend an object above the mat; at least one first connector to couple the play gym to the mat; and at least one second connector to couple the play gym to a play yard and/or a bassinet. None of the art of record teaches or suggests and apparatus with two such connectors. Accordingly, claim 46 must be allowed.

#### **Conclusion**

Before closing, the applicants note that the amendments made throughout the claims are either broadening or clarifying and, thus, not necessary for patentability, with the exception of the addition of the phrase "at least one fastener to couple the floor mat to at least one of a play yard and a bassinet" to the last clause of claim 1. All other amendments were not

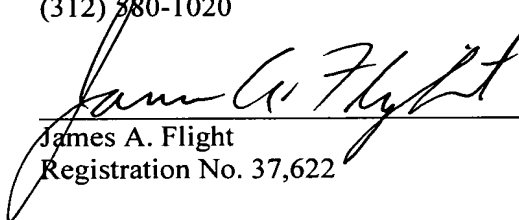
necessary for patentability in that they are either broadening or are merely clarifying in that either (a) the amended claim or claim element is intended to state the same thing as the claim prior to amendment (i.e., to have the same scope both before and after the amendment) in a more easily understood or more conventional fashion. Consequently, these amendments do not give rise to prosecution history estoppel or limit the scope of equivalents of the claims under the doctrine of equivalents.

If the Examiner is of the opinion that a telephone conference would expedite the prosecution of this case, the Examiner is invited to contact the undersigned at the number identified below.

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July 25, 2005